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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,038	02/27/2002	James R. Komorowski	NUTRI.023A	6775
20995	7590	10/20/2004		
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER CHOI, FRANK I	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/090,038

Applicant(s)

KOMOROWSKI ET AL.

Examiner

Frank I Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 23-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 23-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,4-6,8,10-13,17,19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rath (US Pat. 6,693,129).

Rath expressly discloses a method of treating high LDL and high triglycerides by administering a composition containing biotin and chromium glycinate falling within the scope of applicant's claims (Column 6, lines 34-68, Column 7, Column 8, lines 1-20).

Alternatively, at the very least the claimed invention is rendered obvious within the meaning of 35 USC 103, because the prior art discloses products and uses that contain the same exact ingredients/components as that of the claimed invention. See *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980). See also *In re May*, 197 USPQ 601, 607 (CCPA 1978). See also *Ex parte Novitski*, 26 USPQ2d 1389, 1390-91 (Bd Pat. App. & Inter. 1993).

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Examiner has duly considered Applicant's arguments but deems them unpersuasive.

The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. In *re Herz*, 190 USPQ 461, 463 (CCPA 1976) (held that there was no evidence that the presence of a dispersant would materially affect the basic and novel characteristic of the claimed invention. The prior art composition had the same basic and novel characteristic (increased oxidation resistance) as well as additional enhanced detergent and dispersant characteristics). "A 'consisting essentially of' claim occupies a middle ground between closed claims that are written in a 'consisting of' format and fully open claims that are drafted in a 'comprising' format." *PPG Industries v. Guardian Industries*, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998). See also *Atlas Powder Co. v. E.I. duPont de Nemours & Co.*, 224 USPQ 409 (Fed. Cir. 1984); *In re Janakirama-Rao*, 137 USPQ 893 (CCPA 1963); *Water Technologies Corp. v. Calco, Ltd.*, 7 USPQ2d 1097 (Fed. Cir. 1988).

However, for search and examination purposes, absent a clear indication in the specification of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., *PPG*, 48 USPQ at 1355 ("PPG could have defined the scope of the phrase 'consisting essentially of' for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention.").

When an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of

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applicant's invention. In re De Lajarte, 143 USPQ 256 (CCPA 1964). See also Ex parte Hoffman, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989)("Although 'consisting essentially of' is typically used and defined in the context of compositions of matter, we find nothing intrinsically wrong with the use of such language as a modifier of method steps. . . [rendering] the claim open only for the inclusion of steps which do not materially affect the basic and novel characteristics of the claimed method. To determine the steps included versus excluded the claim must be read in light of the specification. . . . [I]t is an applicant's burden to establish that a step practiced in a prior art method is excluded from his claims by 'consisting essentially of language.").

In light of the above, Applicant has not provide sufficient evidence that the use of the phrase "consisting essentially" excludes the other compounds set forth in Rath.

Claims 1-20, 23-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarty (US Pat. 5,789,401) or McCarty (US Pat. 5,929,066), each in view of de la Harpe et al. (US Pat. 5,948,772) and Brand-Miller for the reasons of record set forth in the prior Office Actions and in further view of Rath (US Pat. 6,693,129) and the further reasons below.

McCarty (US Pat. 5,789,401) or McCarty (US Pat. 5,929,066) were discussed in the prior Office Actions and the same are incorporated herein.

de la Harpe et al., Jensen and Brand-Miller were discussed in the prior Office Actions and the same are incorporated herein. Further de la Harpe et al. discloses that chromium increases HDL levels (Column 2, lines 30-38).

Rath discloses a composition containing biotin and chromium glycinate which is effective in lowering LDL and triglycerides which can be administered orally or parenterally,

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and that those skilled in that art would understand that changes can be made and equivalents substituted and that effective amounts may vary depending on variations in patients, durations of treatment, etc. and that modifications may made to adapt a particular situation and composition of matter (Column 5, lines 45-56, Column 6, lines 36-68, Column 7, Column 9, lines 1-33)

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 231 USPQ 375 (Fed. Cir. 1986). Further, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 208 USPQ 871 (CCPA 1981).

de la Harpe discloses that hypercholesterolemia is present in diabetics. (De La Harpe, Column 1, lines 24-36). Diabetics suffer from ineffective insulin and compromised glucose metabolism which leads to hypercholesterolemia. As such, one of ordinary skill in the art would expect that biotin which is known to be effective in controlling the cause of the hypercholesterolemia, i.e. diabetes, hypercholesterolemia which is the result of uncontrolled diabetes would be alleviated by administration of biotin. Contrary to Applicant's arguments, the McCarty references do not provide evidence that the activity of biotin is due to a mechanism independent of the function of insulin. The fact that biotin is effective in type I diabetics does not preclude biotin from acting also by a mechanism which is dependent on the function of insulin.

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Even if such were the case, Applicant's arguments do not take away from the fact that hypercholesterolemia is a symptom of diabetes, as such, one of ordinary skill in the art would expect that treating the underlying cause, i.e. diabetes, would be effective in treating the symptom, i.e. hypercholesterolemia and that the prior art teaches a composition containing both biotin and chromium which is used to lower LDL and triglycerides. As such, contrary to Applicant's arguments, the effectiveness of biotin in altering serum lipid levels is not found exclusively in Applicant's Specification. Further, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. In re Linter, 173 USPQ 560 (CCPA 1972); In re Dillon, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991). As indicated above, Applicant has provided no evidence that the use of the phrase "consisting essentially of" excludes the one or more of the components in Rath. As such, as indicated above, the prior art does disclose or suggest Applicant's claimed invention.

Applicant amends the claims by adding the limitation "synergistically" and cites to Figures 2 and 14 and pages 15 and 25 of the Specification for supported of this synergistic effect. However, the evidence of synergy is not commensurate in scope with the breath of the claims as only specific amounts are tested and only glucose uptake and HDL-change are shown. Whereas the claims broadly claim a synergistically effective dose and/or do not indicate the synergistic effect. Even assuming the evidence of synergy is commensurate in scope with the claims, both McCarty '066 and McCarty '401 disclose the combination of biotin and chromium complex results in synergistic effects (McCarty '066, Column 2, lines 56-65; McCarty '401, Column 2,

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lines 49-57). Since Applicant's arguments relative to biotin are unpersuasive, as indicated above, Applicant's evidence of synergy is not unexpected. See *Ex parte The NutraSweet Co.*, 19 USPQ2d 1586 (Bd. Pat. App. & Inter. 1991) (Evidence showing greater than additive sweetness resulting from the claimed mixture of saccharin and L-aspartyl-L-phenylalanine was not sufficient to outweigh the evidence of obviousness because the teachings of the prior art lead to a general expectation of greater than additive sweetening effects when using mixtures of synthetic sweeteners.).

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

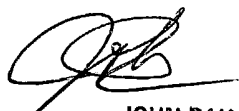
A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (571)272-0610. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Gary Kunz, can be reached at 571-272-0887. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (571) 272-1600.

FIC

October 18, 2004



JOHN PAK
PRIMARY EXAMINER
GROUP 1600